

Remarks

Applicants request reconsideration on the merits of the above-referenced application.

I. Amendments to the claims

This Amendment A does not cancel any claims. Thus, claims 1-24 are pending. This Amendment A amends claims 1-24. The pending claims, including the amendments, are shown in the previous section. Applicants submit that the amendments do not introduce new matter. More specifically:

Claim 1 has been amended to recite a method for generating an adult oviparous teleost ornamental fish rather than a method for generating any ornamental fish. Claim 1 has also been amended to recite that the transgenic fish used in the method of claim 1 (A) comprises (i) one or more transgenes at least one of which encodes a fluorescent protein and (ii) a promoter operably linked to the at least one transgene encoding a fluorescent protein, and (B) expresses the fluorescent protein encoded by the at least one transgene encoding a fluorescent protein. As acknowledged in the Office action, the amendments to claim 1 are supported by Applicants' specification. See, for example, Office action at page 2, second full paragraph; page 3, first full paragraph; and page 4, first full paragraph through page 6, second full paragraph.

Claim 2 has been amended to recite that the transgenic fish and the fish with different phenotype or pattern that are used in the method of claim 1 can be from the same family, genus, or species.

Claim 3 has been amended to depend from claim 1 rather than from claim 2. Claim 3 has also been amended to recite that the transgenic fish and the fish with different phenotype or pattern that are used in the method of claim 1 can be from different family, genus, or species. This amendment is supported by, for example, originally-filed claim 2.

Claims 4, 5, 6, and 7 have been amended to depend from claim 1 rather than from claims 3, 4, 5, and 6, respectively.

Claims 5-7 have been amended to replace the phrase “fluorescent gene” with “fluorescent protein” to be more consistent with claim 1 from which they depend.

Claim 11 has been amended to make it more clear that the term “fish” encompasses the terms “transgenic fish” and “fish with different phenotype or pattern” (i.e., the two types of fish used in the method of claim 1). This amendment is supported by originally-filed claim 4 from which claim 11 depends.

Other amendments rephrase the claims, remove redundancies or unnecessary terms, or correct grammatical or obvious errors. Applicants submit that such amendments are permissible under MPEP §2163.07.

Applicants reserve the right to claim any canceled and/or unclaimed subject matter in one or more later-filed continuation (including divisional) applications.

II. Response to the objections to claims 1, 8, 9, 20, and 21

The Office action objects to claims 1, 8, 9, 20, and 21 for containing informalities, and requests that Applicants correct these informalities. Applicants request withdrawal of the objection. To facilitate prosecution, Applicants have amended claims 1, 8, 9, 20, and 21 as requested by the Office action. Applicants make no representation about the merit of the objections.

III. Response to the rejection of claims 1-24 under 35 U.S.C. §112 (first paragraph)

The Office action rejects claims 1-24 under 35 U.S.C. §112 (first paragraph) for reciting subject matter not enabled by Applicants’ specification. Applicants request withdrawal of the rejection.

A. Claim 1

As discussed above, it is Applicants’ understanding that claim 1 (as amended) is supported by Applicants’ specification. Applicants have made the amendments suggested by the

Office action to facilitate prosecution of the application, and make no representation about the merit of the rejection.

B. Claims 2-22

Claims 2-22 depend (directly or indirectly) from claim 1, and are therefore enabled by Applicants' specification for at least the same reasons discussed above with respect to claim 1.

C. Claim 23

Claim 23 is directed to an ornamental fish made by the method of claim 1. It is Applicants' understanding (based on, for example, the first paragraph on page 3 of the Office action) that claim 23 is supported by Applicants' specification.

D. Claim 24

Claim 24 depends from claim 23, and is therefore enabled by Applicants' specification for at least the same reasons discussed above with respect to claim 23.

IV. Response to the rejection of claims 11-19 under 35 U.S.C. §112 (second paragraph)

The Office action rejects claims 11-19 under 35 U.S.C. §112 (second paragraph) for being indefinite. Applicants request withdrawal of the rejection. As discussed above, Applicants have amended claim 11 to make the meaning of the term "fish".

V. Response to the rejection of claims 1, 2, 8, 9, and 23 under 35 U.S.C. §102(b)

The Office action rejects claims 11-19 under 35 U.S.C. §102(b) for being anticipated by N.T. Lawson & B.M. Weinstein, In Vivo Imaging of Embryonic Vascular Development Using Transgenic Zebrafish, Developmental Biology 248:307-318 (2002). Applicants request withdrawal of the rejection.

A. Claim 1

As discussed above, claim 1 (as amended) is directed to a method for preparing adult oviparous teleost ornamental fish. Applicants submit that the cited reference does not anticipate claim 1 at least because it does not discuss preparing adult and/or ornamental fish.

Lawson & Weinstein discuss preparing embryos or larvae of transgenic EGFP/albino zebrafish in which EGFP expression is restricted to blood vessels throughout embryogenesis. They, however, do not discuss adult transgenic EGFP/albino zebrafish. In addition, transgenic embryos and larvae (and in particular ones with only regionally specific EGFP expression) are not valuable for ornamental use. Thus, the cited reference cannot anticipate claim 1.

B. Claims 2, 8, and 9

Claims 2, 8, and 9 depend from claim 1, and are therefore novel over the cited reference for at least the same reasons discussed above with respect to claim 1.

C. Claim 23

As discussed above, claim 23 is directed to an ornamental fish made by the method of claim 1. Thus, claim 23 is novel over the cited reference for at least the same reasons discussed above with respect to claim 1.

VI. Response to the provisional double patenting objection to claim 2

The Office action states that if claim 1 is found allowable, claim 2 will be objected to as being a substantial duplicate of claim 1. Applicants request withdrawal of the provisional double patenting objection in view of the amendment to claim 2.

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Applicant submits that the claims are in condition for allowance, and requests that the Examiner call the undersigned if any questions arise that can be addressed over the phone to expedite examination of this application.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John A. Castellano at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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By

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